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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,229	05/25/2001	Donald R. Youell JR.	ACP 2-021	2603

7590

03/28/2003

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EXAMINER

DURAND, PAUL R

ART UNIT

PAPER NUMBER

3721

DATE MAILED: 03/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,229

Applicant(s)

YOUELL ET AL.

Examiner

Paul Durand

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The corrected or substitute drawings were received on 1/29/03. These drawings are accepted.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Engles Jr. (US 3,154,898).

Engles discloses the invention as claimed including the method of providing a foam backing board 14 (Engle discloses that it is well known in the prior art to utilize a backing comprised of paperboard), having a front and back, placing an automobile part 10, comprised of metal and glass, on the board 14 leaving exposed areas on the front and shrink wrapping with plastic shrink wrap 16 onto the automobile part and exposed areas of front of the paperboard laminate (see Figs. 1-3, C1, L15-18 and C2, L59-69).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engles Jr in view of Koester (US 3,166,188).

Engles discloses the invention as claimed except for the packaging of an automotive part comprised of window glass, door panel, hood fender or combinations thereof. However, Koester discloses that it is old and well known in the art of packaging to package a windshield 11, in a package 10 formed from fiberboard or similar material for the purpose of protecting the part during shipping (see Fig. 1 and C2, L15-20). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Engles with the packaging means as taught by Koester for the purpose of protecting the part during shipping.

6. Claims 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engles Jr. in view of Gillio-tos et al (US 4,611,456).

In regard to claim 2, Engles discloses the invention substantially as claimed including a paperboard back. What Engles does not disclose is the backing being comprised of a laminate. However, Gillio-tos discloses that it is old and well known in the art to use a backing 1, that can be comprised of a laminate as a means of increasing product durability (See Figs. 8,9 and C3, L20-23). Therefore it would have been obvious to one having ordinary skill in the art to have provided the invention of Engles with a laminate backing as taught by Gillio-tos for the purpose of increasing product durability.

7. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engles Jr. in view of Wilkinson (US 6,010,003).

Engles discloses the invention substantially as claimed except for the method of placing the shrink wrapped packages in a box or container. However, Wilkinson teaches that it is old and well known in the art to place an object "O" that has been shrink wrapped to a backing with wrap 172, in a container "C" for the purposes of protecting the item during shipping (See Figs. 16 and 17). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the invention of Engle with a shipping container as taught by Wilkinson for the purpose of protecting the items during shipping.

Response to Arguments

8. Applicant's arguments filed 1/29/03 have been fully considered but they are not persuasive.

9. In regard to claims 1 and 3, applicant argues that Engles teaches away from the use of paperboard. While Engles does disclose the use of a laminate as a preferred backing, in line 15, he states that the use of a paperboard material as a backing is conventional in nature. The examiner interprets the use of conventional as that of ordinary or commonplace. Furthermore, In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., large automobile parts) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regard to claim 2, Applicant argues that the teaching of Gillio-tos does not teach of the use laminated plies of paperboard. The examiner use of the teaching is to show that it is old and well known in packaging to utilize the concept of laminated plies as a means of increasing protection of the articles being shipped.

In regard to claim 4, Applicant's arguments with respect to the claim have been considered but are moot in view of the new ground(s) of rejection.

In regard to claim 5, applicant argues that the claim 5 is in condition of allowance due to the dependency of claim 1. While the examiner has maintained his rejection in regard to claim 1, the examiner also maintains the rejection of the claim based on the reasons given in paragraph 5 of this Office Action. Wilkinson clearly shows a shrunk wrapped device being placed in a container.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Durand whose telephone number is 703-305-4962. The examiner can normally be reached on 0730-1800, Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi I Rada can be reached on 703-308-2187. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Paul Durand
March 27, 2003



Rinaldi I. Rada
Supervisory Patent Examiner
Group 3700